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No. 325

IN THE

Supreme Court of the United States

OCTOBER TERM, 1949

FORREST H. SMITH, et al.,

Petitioners,

vs.

GENERAL FOUNDRY MACHINE COMPANY, INCORPORATED, et al.,

Respondents.

PETITION FOR WRIT OF CERTIORARI AND BRIEF IN SUPPORT THEREOF

CLARENCE M. FISHER,
W. BROWN MORTON,
Counsel for Petitioners.

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PETITION FOR WRIT OF CERTIORARI

TO THE HONORABLE, THE CHIEF JUSTICE AND ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioners, Forrest H. Smith, et al., pray that a writ of certiorari issue to the United States Court of Appeals for the Fourth Circuit to review the judgment of that court in this cause filed May 6, 1949 (R. 143). A petition for rehearing was denied on June 13, 1949 (R. 149).

A certified transcript of the record in this case, including the proceedings in the Court of Appeals, is furnished herewith in compliance with Rule 38 of the Rules of this Court.

Summary Statement of the Matter Involved

This action arose as an action by petitioners charging respondents with infringement of claims 1, 2 and 3 of petitioners' patent No. 1,811,980, dated June 30, 1931, and claim 3 of petitioners' patent No. 2,051,348, dated August 18, 1936, relating to drying houses for curing tobacco.

Respondents, on the 2nd day of July, 1948 filed a motion for summary judgment (R. 26) on the grounds that the claims relied upon by respondents had not been infringed by respondents. The question of the validity of the claims was not raised by the motion.

The construction of respondents' drying house alleged to constitute the infringement was sufficiently disclosed by the affidavits and accompanying photographs and prints filed in connection with the motion.

Petitioners contended before the lower Court and also before the Court of Appeals of the Fourth Circuit that on a motion for summary judgment involving merely the question of infringement and not the question of validity, the sole question presented was whether or not the language of the claims construed in accordance with the plain import of their terms, so limited the claims as to exclude respondents' structure. In other words, that for the purpose of the motion the claims must be considered as valid and of a scope commensurate with their terms. The lower Court granted the motion without opinion.

The Court of Appeals for the Fourth Circuit, although finding that the combination of elements recited in the claims relied upon was present in respondents' drying house, read into the claims certain additional limitations from the specification, and when so construed found that said claims were not infringed by the respondents' structure.

The drying house disclosed in the patents in suit consists of a tobacco drying barn of ordinary construction provided with so-called flues, also of ordinary construction, said flues consisting of large sheet metal pipes placed about the floor of the barn, usually around the walls, and also across the middle of the barn and connected to a common smoke stack on the outside of the barn. Prior to the invention of the patents in suit it was the common practice to connect the flues to a furnace which was in almost every instance designed for burning wood (R. 42). By the petitioners' invention it was proposed to do away with the wood-burning furnace which was usually installed in the wall of the barn to be fired from the outside, and in lieu thereof to heat the flues by oil burners placed in the barn beneath openings cut in the bottom of the flues.

The patentee contended that by his improvement the individual burners could be spaced about the barn floor in such manner that the flues would be uniformly heated, as distinguished from the prior installations wherein the flues were heated to a higher temperature at one side of the barn adjacent the furnace than prevailed in the flues at their ends connected to the stack. The drawings of the patents in suit disclosed fifteen burners distributed at spaced intervals beneath the flues.

The patents in suit also describe and claim the novel method of connecting the individual flues to the burners, namely, by placing the individual burners under holes in the bottoms of the flues whereby the hot gases generated by the burners pass directly into the flues, and the flues, which are interposed between the burners and the overhanging tobacco, protect the tobacco from the direct radiation of heat from the burners.

Claim one of Patent No. 1,811,980 is typical of the claims in suit.

> "1. In a drying house, the combination with a substantially horizontal flue, extending adjacent to and inside of the walls of said house; of a plurality of spaced openings in the bottom of said flue; a fluid fuel burner positioned under each of said openings; and means for supplying fluid fuel to said burners."

The respondents' structure charged to infringe comprises the usual tobacco barn with the flues arranged around the walls of the barn and also across the middle, and with two burners within the barn each of which is placed beneath a hole on the under side of a cast iron elbow forming part of the flue system. The two burners are so placed with respect to the outside flue connections that each burner heats one half of the flues.

The Court of Appeals, in holding that the claims were not infringed, held that the word "plurality", although including two, should be read in connection with the drawings which show fifteen burners because, according to the Circuit Court of Appeals, a greater number than two burners were required to obtain the "prime purpose" of petitioners' invention, namely, the uniform distribution of heat.

> "We have seen that the prime purpose of the patent was to do away with a central heating system, with its loss of heat and lack of uniformity of temperature in various parts of the drying house, and to substitute a plurality of individual heating units spaced apart and variously located under the flue inside the warehouse so that the heat would be evenly distributed and easily controlled throughout the building" (Opinion, p. 7, R. 143).

Although the Court of Appeals of the Fourth Circuit in its opinion stated that "there is no genuine issue as to any material fact", its decision that the claim must be construed by reading into it limitations from the speci-

fication is itself a decision on an issue of material fact with respect to which petitioners have been denied the opportunity to present evidence. In the case at bar the Court has gone beyond the terms of the claim in an attempt to construe the claim as commensurate with what the Court, on the meager record before it, believes to be the patentee's invention.

The Court's conclusion as to what constitutes the patentee's invention is a decision on "an issue of material fact"—usually the most important fact issue presented in a patent case.

This Court has frequently ruled, that even upon a trial on the merits, the specification of the patent is not to be resorted to in construing the claims either to enlarge or restrict their scope.

> *Graver Tank & Mfg. Co., Inc.*, v. *Linde Air Products Co.*, 336 U. S. 271, 276.
>
> "The Court of Appeals considered that because there was nothing in the record to show that the applicants for the patent intended by these claims to assert a monopoly broader than nine metallic silicates named in the specifications, the court should have construed the claims as thus narrowed and limited by the specifications.
>
> The statute makes provision for specification separately from the claims and requires that the latter 'shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.' R. S. § 4888, as amended, 35 U. S. C. § 33. It would accomplish little to require that claims be separately written if they are not to be separately read. While vain repetition is no more to be encouraged in patents than in other documents, and claims like other statements may incorporate other matter by reference, their text must be sufficient to

'particularly point out and distinctly claim' an identifiable invention or discovery.

We have frequently held that it is the claim which measures the grant to the patentee. See, for example, Milcor Steel Co. v. Fuller Co., 316 U. S. 143, 145 [53 USPQ 268, 269-270]; General Electric Co. v. Wabash Co., 304 U. S. 364, 369 [37 USPQ 466, 468-469]; Altoona Theatres v. Tri-Ergon Corp., 294 U. S. 477, 487 [24 USPQ 308, 313]. While the cases more often have dealt with efforts to resort to specifications to expand claims, it is clear that the latter fail equally to perform their function as a measure of the grant when they overclaim the invention. When they do so to the point of invalidity and are free from ambiguity which might justify resort to the specifications, we agree with the District Court that they are not to be saved because the latter are less inclusive. Cf. General Electric Co. v. Wabash Co., 304 U. S. 364, 373-374 [37 USPQ 486, 470]; see McClain v. Ortmayer, 141 U. S. 419, 424-425; Cimiotti Unhairing Co. v. American Fur Refining Co., 198 U. S. 399, 410."

In granting the motion for summary judgment for noninfringement on an interpretation of the claims not in accord with the meaning of their plain terms, the Court of Appeals for the Fourth Circuit followed a practice condemned by this Court in *Sartor* v. *Arkansas Natural Gas Corporation*, 321 U. S. 620, and directly in conflict with the ruling of the Court of Appeals for the Third Circuit in *Frederick Hart & Co., Inc.* v. *Recordgraph Corporation*, 169 F. 2d 580, 581 (C. C. A. 3):

"We are of the opinion that the District Court erred. It is well-settled that on motions to dismiss and for summary judgment, affidavits filed in their support may be considered for the purpose of *ascertaining whether an issue of fact is presented, but they cannot be used as a basis for deciding the fact issue.*

An affidavit cannot be treated, for purposes of the motion to dismiss, as proof contradictory to well-pleaded facts in the complaint. Farrall v. District of Columbia, Amateur Athletic Union, 1946, 80 U. S. App. D. C. 396, 153 F. 2d 647; United States v. Association of American Railroads, D. C. Neb. 1945, 4 F. R. D. 510; 2 Moore's Federal Practice (2nd ed. 1948) pages 2254, 2255.

It is also well-settled that on a motion to dismiss the complaint must be viewed in the light most favorable to the plaintiff and that the complaint should not be dismissed unless it appears to a certainty that the plaintiff would not be entitled to relief under any state of facts which could be proved in support of his claim; further, no matter how likely it may seem that the pleader will be unable to prove his case, he is entitled, upon averring a claim, to an opportunity to try to prove it."

When the Court of Appeals of the Fourth Circuit concluded that in order for the claims in suit to be commensurate with the patentee's invention it was necessary to read into them limitations from the specifications, the Court of Appeals should have terminated its consideration and denied the motion.

Hart v. *Recordgraph, supra,* (p. 583):

"The foregoing clearly establishes the *existence of a fact issue* with respect to what was actually said by Murray to Weber. It was at that point that the District Court's consideration should have terminated and Recordgraph's motion denied. Instead, the District Court proceeded to *decide* the fact issue and thereby committed error under the applicable principles of law stated earlier in this opinion. It is immaterial that it *decided* the fact issue in Recordgraph's favor—the point is that it went beyond its

province to resolve any fact issue on a motion to dismiss or for summary judgment. Cf. Sarnoff v. Ciaglia,, 3 Cir., 1947, 165 F. 2d, 167."

Even if it be assumed that the specification of the patent may properly be resorted to for limitations not expressed in the claims, the Court of Appeals erred in limiting the claims to include the elements which it believed to be necessary for carrying out the "prime purpose" of the invention, as the claims themselves, without such limitation, define a novel sub-combination, namely, the construction and arrangement of the individual burners with respect to the flues, which is useful whether or not sufficient burners are employed to attain the prime purpose of the invention. It is the established rule of this Court that such combinations are patentable, and as the question of validity was not before the Court the claims should have been construed as defining a novel and patentable sub-combination which is incorporated in the respondents' structure.

Jurisdiction

The jurisdiction of this Court is invoked under Sec. 240(a) of the Judicial Code as amended by the act of February 13, 1925, c. 229 (28 U. S. Code, Sec. 347).

The judgment of the Court of Appeals for the Fourth Circuit which petitioners seek to have reviewed was entered on May 6, 1949 (R. 143) and petition for rehearing denied on June 13, 1949 (R. 149).

Question Presented

The question presented is whether a Court, on a motion for summary judgment for non-infringement, may read into the claims additional limitations from the specifications in an attempt to construe the claims as commensurate with the invention.

Reasons for Granting the Writ

The question presented by this petition is a procedural question with respect to which there is direct conflict between the decision here and the rule of the Circuit Court of Appeals for the Third Circuit in *Hart* v. *Recordgraph, supra*. The question has not been decided by this Court, but should be, as motions for summary judgment in patent cases are frequently presented in an effort by a litigant to save the cost of litigation which in patent cases is usually burdensome. While it is highly desirable that unnecessary litigation expense be avoided, the procedure should not be carried so far as to deny litigants their day in Court.

WHEREFORE YOUR PETITIONERS respectfully pray that a writ of certiorari be issued to the United States Court of Appeals for the Fourth Circuit to the end that this cause may be reviewed and determined by this Court; that the judgment of the Court of Appeals for the Fourth Circuit be reversed; and that petitioners be granted such other and further relief as may be proper.

CLARENCE M. FISHER,
W. BROWN MORTON,
Counsel for Petitioners.

New York, September 8, 1949.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinion of Courts Below

The decision of the District Court appears at page 51 of the Record and is not reported. The opinion of the Court of Appeals for the Fourth Circuit appears at page 136 of the Record and is reported in 174 F. 2d 147.

Jurisdiction

The jurisdictional statement appears in the accompanying petition.

Statement of the Case

The essential facts of the case are stated in the accompanying petition and need not be related here.

Specification of Errors

1. The Court of Appeals for the Fourth Circuit erred in reading into claims 1, 2 and 3 of Patent No. 1,811,980 limitations not expressed therein.

2. The Court of Appeals for the Fourth Circuit erred in not holding that as the language of claims 1, 2 and 3 of Patent No. 1,811,980 did not clearly exclude the accused structure, the question of infringement could not be decided on motion for summary judgment.

3. The Court of Appeals for the Fourth Circuit erred in not holding that as claims 1, 2 and 3 of Patent No. 1,811,980 define a useful sub-combination, they are infringed

by respondents' structure, regardless of the number of burners employed.

4. The Court of Appeals for the Fourth Circuit erred in not holding that claim 3 of Patent No. 2,051,348 covers an improvement on the structure of the individual burners as used in the combination covered by Patent No. 1,811,980 and that that modification is incorporated in respondents' burners.

ARGUMENT

I

The practice of reading into the claims from the specification or elsewhere limitations not therein expressed is so clearly contrary to the ruling of this Court in *Graver, et al.* v. *Linde, supra,* that further argument is superfluous. The claims are not ambiguous. The patentee obviously chose the word "plurality" to designate the number of burners in order that the claims should not be limited in that respect.

II

The question of infringement is a question of law for the Court only when the claims are read as they should be, in accordance with the principles laid down in the case of *Graver, et al.* v. *Linde, supra.*

The purpose of claims is to define the metes and bounds of the grant. If the language of the claims clearly excludes the respondents' structure the issue of infringement may be disposed of by motion for summary judgment. If the language of the claims does not explicitly exclude respondents' structure, then the motion should be denied because any construction of a claim at variance

with its plain language involves the determination of fact issues. In the case at bar the Court has attempted to construe the claims not in accordance with their terms, but in accordance with what the Court believes to be the scope of the patentee's invention.

The scope of a patentee's invention is the fundamental question presented in any infringement case, to determine which it is necessary to determine the state of the art at the time of the patentee's invention and the nature and extent of the departure from existing practice, by a comparison of the patented structure with the existing apparatus. To make this comparison on the basis of excerpts from file wrappers of abandoned applications* (Opinion, R. 142) and from statements in the specification that central heating furnaces are old (Opinion, R. 141)** is directly contrary to the established principle that fact issues are to be determined on the basis of evidence submitted to the jury or to the trial Judge, in cases where a jury is waived or is not required.

III

The claims define a patentable sub-combination.

Special Equipment Company v. *Coe, Com'r. Pats.*, 324 U. S. 370:

> "The statutes permit, and it is the settled practice of the Patent Office, many times sustained by this Court, to allow claims to a combination and also its sub-combinations. Railroad Co. v. Dubois, 12 Wall. 47, 60; Deering v. Winona Harvester Works, supra;

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* The matter quoted from the opinion relates to a different heating system wherein no flues are employed.

** Incidentally, it is plain from the context that by "central heating furnaces" the patentee meant a furnace to which all the flues were connected, and not a furnace located centrally in the barn.

Leeds & Catlin v. Victor Talking Mach. Co., 213 U. S. 301, 318; Altoona Theatres v. Tri-Ergon Corp., 294 U. S. 477, 487 (24 USPQ 308, 313); Mercoid Corp. v. Mid-Continent Co., supra, 667 (60 USPQ at 25)."

Applying this rule to the claims of Patent No. 1,811,980 here in suit, if it be novel to combine oil burners with flues by providing "spaced openings in the bottom of the flue" and positioning "a fluid fuel burner" "under each such opening" the patentee is entitled to claims to that subcombination whether or not the number of burners employed is sufficient to provide the uniform heating of the entire flue area required to carry out the principal object of his invention.

As this case is before the court on a motion for summary judgment on the sole ground of non-infringement, the novelty of the combination recited in the claims is not here in issue.

That this arrangement has utility quite apart from the number of burners employed is self evident. The burner is placed directly on the ground so that the natural air currents carry the heated products of combustion into the overlying flue which protects the tobacco from direct radiation from the burners.

IV

Patent No. 2,051,348 is for the most part directed to a type of heating system for tobacco barns wherein the flues are discarded altogether. However, it shows in Figs. 15-18 a modification of the flue system forming the subject-matter of the earlier patent. Claim 3 here in suit is directed to this improvement. The arrangement of burners and flues in Patent No. 2,051,348 is precisely the same as in Patent No. 1,811,980, the improvement consisting in placing around each burner an enclosure or so-called "boxing" to prevent any escape

of the products of combustion into the barn (Pat. p. 3, col. 1, ll. 73 *et seq.* R. 97). The Court of Appeals questioned the applicability of this claim "taken literally" to the respondents' structure because in this claim the plurality of burners are described as arranged in series, etc., the Court apparently regarding "series" as implying more than two. Petitioners are not in accord with this view, and if this petition be allowed, will argue that the language of the claim, taken literally, does not exclude from its scope the respondents' structure.

Conclusion

By the granting of the motion for summary judgment petitioners have been denied the opportunity of establishing by competent evidence the nature and scope of their invention and its appropriation by respondents. Where the claims are so limited as to plainly exclude the respondents' structure, respondents may not be called to account, even though they have incorporated petitioners' invention in their drying houses, and the dismissal of the suit on motion would have been in order, but as the claims are not so limited, the motion should have been denied and the case remanded to the lower Court to try the fact issues presented by the pleadings.

WHEREFORE, petitioners earnestly pray that this petition for writ of certiorari be granted, the cause reviewed, and the decree of the Court of Appeals for the Fourth Circuit reversed.

Respectfully submitted,

CLARENCE M. FISHER,
W. BROWN MORTON,
Counsel for Petitioners.

Dated: New York, N. Y.,
September 8, 1949.

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OCTOBER TERM, 1949

No. 325

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vs.

GENERAL FOUNDRY MACHINE COMPANY, Incorporated, *et al.*,

Respondents.

REPLY BRIEF FOR PETITIONERS IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

CLARENCE M. FISHER,
W. BROWN MORTON,
Counsel for Petitioners.

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Respondents.

REPLY BRIEF FOR PETITIONERS IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

The brief filed by respondents completely misstates petitioners' position.

It is petitioners' position that having found that the patent claims *did* embrace within their terms the respondents' structure, the motion for summary judgment should have been denied and the question of whether or not the claims were broader than justified by the state of the art should have been left for decision *with the question of validity* upon the trial of the case.

Respondents in paragraph IV of their summary of argument, page 4 of their brief say:

> "It is well settled that the claims of a patent are always to be read and interpreted in the light of the patent specification."

The phrasing of this statement implies that the claims of a patent depend for their meaning upon the specification—this is not the case. It has always been the rule that the specification may be resorted to only when the language of the claims is ambiguous. *Evans* v. *Eaton,* 16 Wheat. 454, 506. Unless it is ambiguous a claim must stand or fall on its own. *Altoona Theatres* v. *Tri-Ergon Corp.,* 294 U. S. 477, 487.

In *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.,* 336 U. S. 271, 277, this Court specifically held that where the claims "are free from ambiguity which might justify resort to the specifications" they must be read in accordance with their specific terms.

We do not mean that a claim must always be literally construed. The *evidence* submitted at the trial may develop facts which show that the apparently plain language of the claims does not in fact define the patentee's invention. In other words, the *evidence* may establish an ambiguity which is not apparent on the face of the patent.

But this is a motion for summary judgment for non-infringement. On such a motion "the complaint must be viewed in the light most favorable to the plaintiff and the complaint should not be dismissed unless it appears to a certainty that the plaintiff would not be entitled to relief under any state of facts which could be proved in support of his claim." *Frederick Hart & Co., Inc.* v. *Recordgraph Corporation,* 169 F. 2d 580, 581 (C. C. A. 3). To read into the claims limitations not therein expressed is not viewing "the complaint in the light most favorable to the plaintiff."

The Court of Appeals in its decision (R. 140) asserts that "the range of equivalents depends upon the extent and nature of the invention." The rule so stated is well established, but it is petitioners' position that the extent and nature of the invention, except as defined in the patent claims, should not be determined on motion for summary

judgment, and *cannot* be decided in this case without deciding "genuine issue of material fact" (Rule 56, Federal Rules of Civil Procedure).

The respondents' circulars (R. 36, 110) claim for the accused structure with two burners the same accurate temperature regulation that is asserted in the patent to be obtained by a plurality of burners. Petitioners contend that the respondents' construction is the equivalent of the patented construction. Respondents assert that it is not. This is a "genuine issue of material fact."

The Court of Appeals relies for support of its decision of this question of fact—that two burners are not enough—on an affidavit filed by petitioners in another case (R. 141), ignoring petitioners' assertion that the affidavit in question related to a different type of installation wherein no flues were employed. In accepting this affidavit as material evidence in this case the Court of Appeals for the Fourth Circuit also decided a "genuine issue of material fact."

In deciding that the claims were not infringed as subcombination claims to a novel and patentable arrangement of flues and heaters regardless of whether the number of heaters employed were sufficient to accomplish the principal object of patentee's invention the Court of Appeals also decided fact issues not presented by the motion.

Conclusion

This case presents an important question of procedure. We know of no case—and respondents have cited none—where this Court or any other court has granted a motion for summary judgment for non-infringement where the language of the claims was plain and unambiguous and squarely embraced the accused structure.

The Summary Judgment Rule (56) when properly applied no doubt contributes significantly to the simplification of the Federal Procedure which was one of the objects of the new Rules. It was not, however, the purpose of the Rule to require litigants to substitute the summary judgment procedure for trial in open court.

The metes and bounds of Rule 56 have not been laid down by this Court, but should be. Is the Summary Judgment procedure to be confined strictly to questions of law arising out of admitted facts as decided by the Court of Appeals for the Third Circuit in *Hart* v. *Recordgraph Corporation, supra,* or may the admitted facts—the patent claims and the accused structure—be modified by *inferences* of fact drawn from a *res gestae* of excerpts from proceedings in other cases, etc., as has been done by the Court of Appeals for the Fourth Circuit in this case?

Respectfully,

CLARENCE M. FISHER,
W. BROWN MORTON,
Counsel for Petitioners.

New York, N. Y.
November 1, 1949.

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OCTOBER TERM, 1949.

No. 325.

FORREST H. SMITH, ET AL., *Petitioners*,

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GENERAL FOUNDRY AND MACHINE COMPANY, ET AL., *Respondents*.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

There are no grounds stated in the petition herein, or in the petitioners' brief, that establish any basis for bringing this case within the provisions of Section 5 of Rule 38 of this Court.

This is simply an ordinary patent case involving the usual issue of infringement, which has been disposed of by summary judgment in the District Court below (R. 51) on well settled principles under Rule 56 of the Federal Rules of Civil Procedure, and which has been reviewed and affirmed by the Court of Appeals for the Fourth Circuit (174 F. (2d) 147; R. 136). The patents in suit have not been litigated in any other circuit.

The only ground advanced for granting the petition (Petition, page 9) is an allegation that "there is direct conflict between the decision here and the rule of the Circuit Court of Appeals for the Third Circuit in *Hart* v. *Recordgraph*," 169 F. (2d) 580 (C. C. A. 3rd, 1948), regarding the granting of motions for summary judgment. The rule in *Hart* v. *Recordgraph*, however, is merely to the effect that an affidavit cannot be relied on to determine a material fact at issue, with which everyone should agree, but which has no bearing whatever on the present case where there has never been any question as to any of the affidavits filed by either side, and where the facts relied on by the District Court and the Court of Appeals in deciding the issue of infringement are clearly established of record and acknowledged by both sides without question.

Moreover, petitioners' statement of the question presented in this case (Petition, page 8) does not even infer that there was any material fact at issue here, as in *Hart* v. *Recordgraph*, *supra*, but instead attacks the action of the Court of Appeals in deciding the ultimate issue of infringement. What the petition in this case is really requesting is a reconsideration by this Court of the issue of infringement which has been decided adversely to petitioners in both the District Court and the Court of Appeals below, and which neither requires nor warrants any further consideration.

Statement of the Case.

Petitioners' complaint in this case charged respondents with infringement of two patents Nos. 1,811,980 and 2,051,348 (R. 9 and 17), which cover a tobacco barn or drying house equipped with a plurality of small unit oil burners spaced throughout the drying house to obtain an alleged improvement in uniformity of heating. That the distinguishing feature of the patents in suit was this different multiple arrangement of small unit burners to obtain uniformity of heating, in contrast with the conventional cen-

tral heating type of system commonly employing wood-burning furnaces, is clear on the face of the patents, and was readily recognized by both the District Court and the Court of Appeals below.

Respondents' structure consists simply of a straight forward substitution of either one or two large capacity oil burners as central heating units (*which are acknowledged in patent No. 1,811,980 in suit to be old in the art*) in a tobacco barn in place of either one or two conventional wood-burning furnaces. Petitioners admitted in the District Court that respondents' single unit installation did not infringe the patents in suit, but alleged that the two burner installation of the same type did infringe. There is no real difference in function or arrangement of respondents' oil burners when two are used instead of one, and as a matter of fact the two oil burner installations are only used by respondents in the relatively few instances where very large barns require the greater heating capacity of two burners.

Complete diagrams, photographs, and descriptions of respondents' installations were before both the District Court and the Court of Appeals, together with actual full size embodiments of respondents' oil burners, and it is admitted by petitioners that these installations were fully disclosed of record. Also, the file wrappers and contents of each of the patents in suit were before both the District Court and the Circuit Court of Appeals. Petitioners have never attempted to show any facts that would contradict any material fact presented in support of respondents' motion for summary judgment.

The District Court, after finding that there was no genuine issue as to any material fact, and after comparing respondents' installations with the patents in suit, granted respondents' motion for summary judgment on the ground that the patents in suit were not infringed, and the Court of Appeals reached the same conclusion.

Argument.

SUMMARY:

I. There is no genuine issue as to any material fact regarding the patents in suit or the structure accused of infringement.

II. It has always been held that the question of infringement may be determined as a question of law when there is no genuine issue as to the material facts.

III. The Court of Appeals in finding no infringement did not read into the claims of the patents in suit any additional limitations, but simply recognized the reasonable and intended meaning of the claims in the light of their specifications.

IV. It is well settled that the claims of a patent are always to be read and interpreted in the light of the patent specification.

V. As it is admitted in this case that the structure accused of infringement is fully disclosed of record, and as the patents in suit are clear on their face, it was entirely proper for the District Court and the Court of Appeals to compare the accused structure with the patents in suit and decide the issue of infringement as a matter of law on respondents' motion for summary judgment.

I.

As this is a patent infringement suit the material facts of primary importance are the texts of the specification and claims of the patents in suit, and the details of the structure accused of infringement. Complete file wrappers of both of the patents in suit were made of record at the time respondents' motion for summary judgment was filed, and complete information regarding the structure accused of infringement was made a part of the record at the same

time. Petitioners have never raised any question regarding the sufficiency of the record in this respect, and, as previously noted, petitioners admit that the structure accused of infringement is fully disclosed of record.

II.

The decisions of this Court clearly establish that the question of infringement is an ultimate issue which may be decided as a question of law when there is no genuine issue as to the material facts. This rule was recognized by this Court in the case of *United States* v. *Esnault-Pelterie*, 303 U. S. 26, 30, (1938), in which the Court said:

> "We are not unmindful of the rule that where, with all the evidence before the court, it appears that no substantial dispute of fact is presented, and that the case may be determined by a mere comparison of structures and extrinsic evidence is not needed for purposes of explanation, or evaluation of prior art, or to resolve questions of the application of descriptions to subject matter, the questions of invention and infringement may be determined as questions of law. (*Citing cases*)"

The rule was also clearly stated by this Court in the earlier case of *Singer Mfg. Co.* v. *Cramer*, 192 U. S. 265, 275 (1904), as follows:

> "As in each of the patents in question it is apparent from the face of the instrument that extrinsic evidence is not needed to explain terms of art therein, or to apply the descriptions to the subject-matter, and as we are able, from mere comparison to comprehend what are the inventions described in each patent, and from such comparison, to determine whether or not the Diehl device is an infringement upon that of Cramer, the question of infringement or no infringement is one of law, and susceptible of determination on this writ of error."

To the same effect is *Vulcan Corporation* v. *International Shoe Machine Corporation*, 68 F. Supp. 990 (D. C. Mass., 1946), affirmed per curiam, 158 F. (2d) 520 (C. C. A. 1st,

1946), certiorari denied, 330 U. S. 825, (1947); and *Steigleder* v. *Eberhard Faber Pencil Co.*, No. 4411, decided August 9, 1949 (C. C. A. 1st).

It is clear that both the District Court and the Court of Appeals below were convinced from the record that infringement could not be established in this case, and petitioners, although having ample opportunity to do so, have never made the least effort to show that any extrinsic evidence exists which would or even could alter this conclusion.

III.

There is a contention repeated over and over again in the petition and brief by petitioners herein, that the Court of Appeals in finding no infringement read into the claims of the patents in suit additional limitations. The additional limitations said by petitioners to have been read into the claims are stated in the petition as follows (Petition, page 4):

> "The Court of Appeals in holding that the claims were not infringed held that the word 'plurality', although including two, should be read in connection with the drawings which show fifteen burners because, according to the Circuit Court of Appeals, a greater number than two burners were required to obtain the 'prime purpose' of petitioners' invention, namely, the uniform distribution of heat."

This contention may be judged best by simply comparing the opinion of the Court of Appeals, which reads in pertinent part as follows:

> "The principles governing the question of infringement are well established and when they are applied to the facts of this case, it becomes clear that the defendant does not employ the system that the plaintiff has devised.
>
> "This is so, *not merely because the defendant uses only two instead of many burners*, but because the defendant's arrangement is not intended to and does not

effect the purpose which the patent structure was expressly designed to accomplish. We have seen that the prime purpose of the patent was to do away with a central heating system, with its loss of heat and lack of uniformity of temperature in various parts of the drying house and to substitute a plurality of individual heating units spaced apart and variously located under the flue inside the warehouse so that the heat would be evenly distributed and easily controlled throughout the building. But the defendants have not abandoned the central heating system. It is true that they employ fuel burners inside the barn, as was shown in patents prior to those in suit, and that in the accused structure, two burners are employed; but these are centrally located side by side where the two ends of the flue system are brought to the middle portion of the barn. There is no attempt to space the burners apart and to supply heat at various points so as to maintain a uniform temperature throughout. Only one and sometimes two burners, depending upon the size of the barn, are used, and these of necessity are of much greater power than the burners of the patent under its system of distributing the sources of heat throughout the building." (Italics added.)

* * * * *

"This discussion also shows that claim 3 of the second patent was not infringed. If the language of the claim is to be taken literally, *it is plain that the defendants do not use a plurality of heat units in the building 'arranged in series extending around adjacent to the walls thereof'; but it is more important that the defendants, as we have shown, are not using the heating system which the plaintiff devised.* It is also clear that the defendants, in connecting the ends of their flue system to the burners by iron elbows, are following the early practice of connecting the flues with a central heating system rather than the boxing system of the second patent." (Italics added.)

It could hardly be clearer that it was only in passing that the Court of Appeals even mentioned the word "plurality" in the claims of the patents in suit, and that the holding of non-infringement is based on the reasonable and intended

meaning and scope of the claims of the patents in suit, quite apart from any significance that the word "plurality" may have.

IV.

That the meaning and scope of patent claims are to be determined, as the Court of Appeals has done here, in the light of the accompanying specification, is not open to question. The decision of this Court in *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U. S. 211, 217 (1940), states the rule as follows:

> "The claims of a patent are always to be read or interpreted in the light of its specifications, (*citing cases*); and we may assume that if in the present case the specifications and claims of the patents were to be interpreted without reference to its file wrapper history, *the webs referred to in the claims are the webs described in the specifications . . .* " (Italics added.)

This rule is consistently recognized and followed by the several Courts of Appeal, as in *Wheeling Stamping Co.* v. *Standard Cap & Moulding Co.*, 155 F. (2d) 6 (C. C. A. 4th, 1946), certiorari denied, 329 U. S. 764 (1946).

Graver Tank & Mfg. Co. v. *Linde Air Products Co.*, 336 U. S. 271 (1949), cited by petitioners, is not to the contrary. The *Graver* case merely holds that technically specific terms of a claim cannot be restricted in the light of its specification to save the validity of the claim, which is an entirely different thing from determining the reasonable and intended meaning of terms of general description in a claim by reading and interpreting the claim in the light of its specification, as the Court of Appeals has done here, and as this Court has repeatedly said should be done.

V.

The petition in this case does not present to this Court for the first time the question of whether summary judgment may properly be granted in a patent infringement

suit on the ground of non-infringement. An exactly similar situation was presented quite recently in *Vulcan Corporation* v. *International Shoe Corporation, supra,* and this Court denied certiorari.

Moreover, the principles governing the granting of summary judgment are well settled in the federal courts, and this is so in regard to patent cases as well as any other type of case. All of the following patent cases have been decided by summary judgment: *Steigleder* v. *Eberhard Faber Pencil Co., supra; Rubinstein* v. *Silex Co.,* 73 F. Supp. 336 (D. C. S. D. N. Y., 1947); *Juniper Mills, Incorporated* v. *J. W. Landenberger & Co.,* 6 F. R. D. 463 (D. C. E. D. Penn., 1947); *Brown* v. *Ford Motor Company,* 57 F. Supp. 825 (D. C. E. D. Mich., 1944); *Allen* v. *Radio Corporation of America,* 47 F. Supp. 244 (D. C. Del., 1942); *John T. McCoy, Inc.* v. *Schuster,* 44 F. Supp. 499 (D. C. S. D. N. Y., 1942); and *S. R. Leon, Inc.* v. *Parfums Schiaparelli, Inc.,* 35 F. Supp. 641 (D. C. S. D. N. Y., 1940). Where the issue of infringement is involved, the principles were well stated by the First Circuit in the *Steigleder* case, as follows:

> "Where it is apparent that there is no genuine issue of fact bearing on infringement and the structure and mode of operation of the accused device are such that they may be readily comprehended by the court, and compared with the invention described and claimed in the patent without the need of technical explanation by the testimony of expert witnesses, then the court if satisfied that there is no infringement, should give summary judgment for the defendant instead of subjecting the parties to the expense of a trial."

Conclusion.

The ultimate issue of infringement in the present case was properly determined by the District Court and the Court of Appeals below as a matter of law on respondents' motion for summary judgment. The alleged conflict regarding the law of summary judgments on which the peti-

tion in this case purports to be based is clearly without substance, and the authorities cited by petitioners are not in point and raise no question regarding the decisions of the District Court and Court of Appeals herein.

It is respectfully submitted that the petition fails to advance any proper ground for granting a writ of certiorari in this case; and in particular fails to show any conflict of opinion among the several Courts of Appeal, or any error herein by the Court of Appeals for the Fourth Circuit, regarding summary judgment procedure, or any other basis that would warrant exercise by this Honorable Court of its supervisory authority.

It is submitted that the petition should be denied.

Respectfully,

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